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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,044	02/25/2004	Yoel Cohen	26029	8550
20529	7590	06/15/2006		
NATH & ASSOCIATES 112 South West Street Alexandria, VA 22314			EXAMINER HOGE, GARY CHAPMAN	
			ART UNIT 3611	PAPER NUMBER

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/785,044	Applicant(s) COHEN ET AL.	
	Examiner Gary C. Hoge	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,15,19-22 and 29 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-8 is/are allowed.
- 6) ☒ Claim(s) 1,2,9-14,16,18 and 23-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Species I in the reply filed on August 24, 2005 is acknowledged. However, Applicant erroneously included claim 15 (which is directed to Species VI) and claims 21 and 22 (which depend from non-elected claim 20). Accordingly, these claims are withdrawn from further consideration, as set forth immediately below.
2. Claims 3, 4, 15, 19-22 and 29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 24, 2005.
3. Claims 6-8, previously withdrawn are hereby rejoined as being dependent upon an allowed claim.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 31-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 31, there is no antecedent basis for "the first portion" and "said second portion".

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 9-12, 14, 16-18, 23-25, 28, 30 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Babaz (WO 94/20309).

Babaz discloses a display aid comprising a user interface portion 17 and a handle mounting portion 5, wherein the handle mounting portion is deformable between a first position (Fig. 7) in which it is substantially flat and a second position (Fig. 8) where it is deformed so as to assume a hook-like configuration adapted for hooking the mounting portion onto a handle of a cart.

Regarding claim 2, see Fig. 8 and note that the handle mounting portion has a first portion that is bent into a hook shape, and a second, triangular portion spaced from the hook portion to define a zone therebetween for accommodating the handle.

Regarding claim 3, the angled portions bounding opening 13 (Fig. 7) constitute a double-lobed portion, and the portion extending vertically from 5 (Fig. 7) constitutes a hook portion.

Regarding claim 12, the pad disclosed by Babaz consists of sheets of paper, which are erasable when written upon with a pencil.

Regarding claims 16 and 17, it has been held that although printed matter must be considered, where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401. In this case, there is no functional relationship between the printed matter and the substrate. Rather, the relationship of the substrate to the printed matter is merely that of support and display.

Regarding claim 18, the display aid disclosed by Babaz is rectangular, which is a common shape of commercial elements.

Regarding claims 24 and 25, see Fig. 7.

Regarding claim 30, the handle mounting portion embraces the top portion of the handle, as can be seen in Fig. 8.

### *Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 13 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Babaz (WO 94/20309) in view of Berrier (6,250,006).

Regarding claim 13, Babaz discloses the invention substantially as claimed, as set forth above. However, the pad disclosed by Babaz does not appear to include a partial preset list of items with a tic box associated with each item. Berrier teaches that it was known in the art to

provide a pad for grocery shopping in which the pad includes a partial preset list of items with a tic box associated with each item. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the pad disclosed by Babaz with a partial preset list of items with a tic box associated with each item, as taught by Berrier, in order to assist the user in keeping track of which items have been selected.

Regarding claim 26, Babaz discloses the invention substantially as claimed, as set forth above. However, the aid disclosed by Babaz is held against a support surface by a nail. Berrier teaches that it was known in the art to provide a sheet of magnetic material to the back of a display aid, for the purpose of allowing the aid to be conveniently displayed on a refrigerator. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the aid disclosed by Babaz with a magnetic sheet, as taught by Berrier, in order to allow the aid to be conveniently displayed on a refrigerator.

11. Claim 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Babaz (WO 94/20309) in view of Hockensmith (4,488,366).

Babaz discloses the invention substantially as claimed, as set forth above. However, the aid disclosed by Babaz is held against a support surface by a nail. Hockensmith teaches that a hook-and-loop arrangement is a functionally equivalent structure known in the art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the aid disclosed by Babaz with a hook-and-loop arrangement, as taught by Hockensmith, in order to allow the aid to be displayed on a wall without having to punch a hole in the wall.

*Allowable Subject Matter*

12. Claims 5-8 are allowed.

***Response to Arguments***

13. Applicant's arguments filed March 31, 2006 have been fully considered but they are not persuasive.

Regarding Babaz, Applicant points out that the tab 5 assumes a closed loop configuration by locking onto the back of the plate. That is true, but such a configuration is just as “hook-like” as an open-loop configuration. A “hook” is merely “a curved or bent device for catching, holding, or pulling” (*Webster's Ninth New Collegiate Dictionary*, 1985). The tab disclosed by Babaz is a curved device for holding the display aid on the handle of a cart. Applicant stresses the idea that his hook has a free end, but this feature is not mentioned in the claims. Further, even if Applicant were correct in his narrow definition of a hook, it is noted that the claim requires a hook-like configuration, which merely means that it resembles, in some way, a hook. The tab disclosed by Babaz resembles a hook, in that it is curved. Therefore, it is “hook-like”.

***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

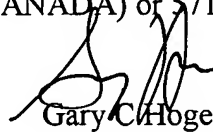
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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gary C. Hoge  
Primary Examiner  
Art Unit 3611

gch